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EXAMINER
VAN HANDEL, MICHAEL P

ART UNIT	PAPER NUMBER
2424	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/848,931	RASHKOVSKIY ET AL.
	Examiner	Art Unit
	MICHAEL VAN HANDEL	2424

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 November 2008</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-4,6-19 and 31-47</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-4, 6-19, 31-47</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This action is responsive to an Amendment filed 11/20/2008. Claims **1-4, 6-19, 31-47**

are pending. Claims **1, 4, 11, 31, 36,** and **44** are amended. Claims **5, 20-30** are canceled. The

examiner hereby withdraws the objections to claims **4, 36,** and **44** in light of the amendments.

Response to Arguments

1.   Applicant's arguments regarding claims **1, 11,** and **31,** filed 11/20/2008, have been fully

considered, but they are not persuasive.

        Regarding claims **1, 11,** and **31,** the applicant argues that Arsenault et al. does not

disclose analyzing the content to identify a location to insert the advertisement within the content

and, based on said analysis, finding a place to insert said advertisement in said portion. The

examiner respectfully disagrees. Arsenault et al. discloses that, based on the intended use of

additional material 172 and advertising 174 for playback of cached program 170, CPU 74

organizes and retrieves respective data packets from additional cache memory 92 in appropriate

order (col. 18, l. 1-5). This is illustrated in Figure 8, where the transmission stream is received as

illustrated at 160, but played back in accordance with playback options 162, 164, 166, or 168

based on the intended use of the additional material and advertising (Fig. 8). The examiner

interprets organizing and retrieving the data packets from cache memory in appropriate order

based on the intended use of the additional material and advertising as "analyzing the content to

identify a location to insert the advertisement within the content and, based on said analysis,

finding a place to insert said advertisement in said portion," as currently claimed.

Regarding Applicant's request to defer the provisional double patenting rejection, the

examiner notes that when the examiner becomes aware of two copending applications that would

raise an issue of double patenting if one of the applications became a patent, the courts have

sanctioned the practice of making Applicant aware of the potential double patenting problem by

permitting the examiner to make a "provisional" rejection on the ground of double patenting.

The "provisional" double patenting rejection should continue to be made by the examiner in each

application as long as there are conflicting claims in more than one application unless that

"provisional" double patenting rejection is the only rejection remaining in at least one of the

applications (see MPEP 804 I.B.).

Double Patenting

1.   The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection
is appropriate where the conflicting claims are not identical, but at least one examined
application claim is not patentably distinct from the reference claim(s) because the examined
application claim is either anticipated by, or would have been obvious over, the reference
claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re
Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re
Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may
be used to overcome an actual or provisional rejection based on a nonstatutory double patenting
ground provided the conflicting application or patent either is shown to be commonly owned
with this application, or claims an invention made as a result of activities undertaken within the
scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2.   Claims **1-4, 6-19, 31-47** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **20-49** of copending Application No. 09/561,443. Although the conflicting claims are not identical, they are not patentably distinct from each other, because they are obvious variations of claims **20** and **37** or are variations of claims that depend therefrom.

Claims **1, 11,** and **31** of the instant application correspond to claims 28 and 43 of the '443 application, where claim 1 recites a method corresponding to the system of claim 28 and claim 11 recites a method performed by instructions executed by a processor-based system corresponding to claim 28. Claim 31 differs from claim 37 of the '443 application in that it recites that the content includes "an interruptible content portion." Claim 43, which depends from claim 37, recites that the receiver parses instructions for determining when said content may be interrupted. Thus, it is inherent to claim 43 that the content contains an interruptible content portion, since it determines when the content may be interrupted. Claim 31 also differs in that it recites outputting "for display, said portion with an inserted advertisement." Claim 46, which depends from claim 37, recites finding a place to insert the advertisement in the content in the cache, such that thereafter "the display of content is terminated, followed by display of the advertisement, followed by resumption of the display of content." Thus, it is inherent to claim 46 that the portion with an inserted advertisement is output for display. As such, the examiner concludes that claim 31 is an obvious variation of claim 37 of the '443 application, given the limitations recited in claims dependent on claim 37.

Claim **3** of the instant application corresponds to claim 21 of the '443 application.

Claim **4** of the instant application corresponds to claim 25 of the '443 application.

Claim **6** of the instant application corresponds to claim 26 of the '443 application.

Claim **7** of the instant application corresponds to claim 42 of the '443 application.

Claim **8** of the instant application corresponds to claim 43 of the '443 application.

Claim **9** of the instant application corresponds to claim 22 of the '443 application.

Claim **10** of the instant application corresponds to claim 29 of the '443 application.

Claim **13** of the instant application corresponds to claim 21 of the '443 application.

Claim **14** of the instant application corresponds to claim 25 of the '443 application.

Claim **15** of the instant application corresponds to claim 26 of the '443 application.

Claim **16** of the instant application corresponds to claim 27 of the '443 application.

Claim **17** of the instant application corresponds to claim 28 of the '443 application.

Claim **18** of the instant application corresponds to claim 22 of the '443 application.

Claim **19** of the instant application corresponds to claim 29 of the '443 application.

Claim **32** of the instant application corresponds to claim 21 of the '443 application.

Claim **33** of the instant application corresponds to claim 38 of the '443 application.

Claim **34** of the instant application corresponds to claim 39 of the '443 application.

Claim **35** of the instant application corresponds to claim 40 of the '443 application.

Claim **36** of the instant application corresponds to claim 41 of the '443 application

(where it is well-known within the prior art that a shell provides an interface for performing the

desired function).

Claim **37** of the instant application corresponds to claim 26 of the '443 application.

Claim **38** of the instant application corresponds to claim 42 of the '443 application.

Claim **39** of the instant application corresponds to claim 43 of the '443 application.

Claim **40** of the instant application corresponds to claim 29 of the '443 application
(where it is well-known within the prior art that a shell provides an interface for performing the
desired function).

Claim **41** of the instant application corresponds to claim 44 of the '443 application.

Claim **42** of the instant application corresponds to claim 45 of the '443 application
(where it is well-known within the prior art that a shell provides an interface for performing the
desired function).

Claim **43** of the instant application corresponds to claim 32 of the '443 application.

Clam **46** of the instant application corresponds to claim 46 of the '443 application.

Claims **2** and **12** are obvious variations of the '443 application, because receiving content
over a broadband distribution system is well known within the prior art, as disclosed by U.S.
Patent No. 6,971,119 to Arsenault et al. Such a modification is desirable in order to increase the
information-carrying capacity of an information channel.

Claims **44**, **45**, and **47** are obvious variations of the '443 application, because detecting a
pause in the display of content and inserting an advertisement in response to the pause is well
known within the prior art, as disclosed by U.S. Patent No. 7,017,173 to Armstrong et al. Such a
modification is desirable in order to put "freeze frame" or other similar display imagery to
greater uses (Armstrong et al. col. 1, l. 63-67).

NOTE: This is a <u>provisional</u> obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

2.   Claims **1-3, 6, 7, 10-13, 15, 16, 19, 31, 32, 37, 38, 40, 42, 43, 46** are rejected under 35

U.S.C. 102(e) as being anticipated by Arsenault et al.

    Referring to claims **1, 11,** and **31**, Arsenault et al. discloses a method/medium/system

comprising:

- receiving content and an advertisement (col. 17, l. 53-67; col. 18, l. 1-19; & Fig. 8);

- storing said content, including an interruptible content portion, and advertisement in a

    cache coupled to said receiver (col. 17, l. 53-67; col. 18, l. 1-19; & Fig. 8);

- analyzing the content to identify a location to insert the advertisement within the

    content and, based on said analysis (col. 18, l. 1-5), finding a place to insert said

    advertisement (164, 168) in said portion while said portion is still stored in said cache

    (col. 18, l. 1-19 & Fig. 8);

- inserting said advertisement in said portion (Fig. 8); and

- outputting for display (164, 168) said portion with said inserted advertisement (Fig.

    8).

Referring to claims **2** and **12**, Arsenault et al. discloses the method/medium of claims 1 and 11, respectively, including receiving said content over a broadband distribution system (col. 3, l. 36-43 & col. 4, l. 3-6).

Referring to claims **3** and **13**, Arsenault et al. discloses the method/medium of claims 2 and 12, respectively, including receiving television programming (col. 3, l. 36-38 & col. 4, l. 65-67).

Referring to claims **6**, **15**, and **37**, Arsenault et al. discloses the method/medium/system of claims 1, 11, and 31, respectively, including a tuner that tunes to a digital channel and demodulates said content and advertisement (col. 9, l. 34-40, 63-64 & Fig. 3).

Referring to claims **7**, **16**, and **38**, Arsenault et al. discloses the method/medium/system of claims 6, 15, and 31, respectively, including parsing said content and said advertisement from control information (col. 5, l. 20-29; col. 9, l. 63-67; & col. 10, l. 1-10).

Referring to claims **10**, **19**, and **40**, Arsenault et al. discloses the method/medium/system of claims 1, 11, and 31, respectively, including receiving encrypted content and a shell controlling the decryption of said content to prevent theft of said content (col. 15, l. 1-11).

Referring to claim **32**, Arsenault et al. discloses the system of claim 31, wherein said system is a television receiver (Fig. 3).

Referring to claim **42**, Arsenault et al. discloses the system of claim 31, wherein said shell is coupled to said cache to allow the use of the content received by said receiver, automatically interrupt the use of the content, and temporarily replace the content with the advertisement (col. 18, l. 1-19 & Figs. 3, 8).

Referring to claim **43**, Arsenault et al. discloses the system of claim 31, wherein said

cache is an encrypted cache (the data is stored in an encrypted MPEG format)(col. 10, l. 11-24).

Referring to claim **46**, Arsenault et al. discloses the method of claim 1, including

displaying content information with said advertisement (Fig. 8).

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claims **4, 8, 9, 14, 17, 18, 33-36, 39, 41** are rejected under 35 U.S.C. 103(a) as being

unpatentable over Arsenault et al. in view of Zigmond et al.

Referring to claims **4, 14,** and **36**, Arsenault et al. discloses the method/medium/system

of claims 1, 11, and 31, respectively, wherein inserting the advertisement in said portion includes

a shell that replaces at least part of said content with the advertisement (col. 18, l. 1-19 & Fig. 8).

Arsenault et al. does not specifically disclose periodically replacing content with a single ad.

Zigmond et al. discloses a system and method for selecting and inserting advertisements into a

video programming feed at the household level (see Abstract). Zigmond et al. further discloses

inserting the same ad into content multiple times (col. 13, l. 40-45). It would have been obvious

to one of ordinary skill in the art at the time that the invention was made to modify Arsenault et

al. to insert the same advertisement multiple times, such as that taught by Zigmond et al. in order

to provide an improved system for directing television advertisements to interested viewers

(Zigmond et al. col. 3, l. 62-64).

Referring to claims **8, 17, 34**, and **39**, Arsenault et al. discloses the

method/medium/system of claims 7, 16, and 31. Arsenault et al. does not disclose that parsing

content from control information includes parsing from said content, instructions for determining

when said content may be interrupted. Zigmond et al. discloses a system and method for

selecting and inserting advertisements into a video programming feed at the household level (see

Abstract). Zigmond et al. further discloses inserting the advertisements at an appropriate time

based on a triggering event, which may be a time specified by encoded data in the video

programming feed (col. 4, l. 40-43; col. 7, l. 26-29; & col. 17, l. 21-31). It would have been

obvious to one of ordinary skill in the art at the time that the invention was made to modify

Arsenault et al. to encode a time for inserting advertisements into the video programming, such

as that taught by Zigmond et al. in order to provide an improved system for directing television

advertisements to interested viewers (Zigmond et al. col. 3, l. 62-64).

Referring to claims **9, 18**, and **33**, Arsenault et al. discloses the method/medium/system

of claims 7, 16, and 31, respectively. Arsenault et al. does not disclose receiving instructions

from a back channel for controlling the interruption of said content. Zigmond et al. discloses a

system and method for selecting and inserting advertisements into a video programming feed at

the household level (see Abstract). Zigmond et al. further discloses delivering ad selection rules

over telephone or downloading them from the World Wide Web (col. 11, l. 66-67 & col. 12, l. 1-

9). The ad selection rules match the viewer with the advertisements to efficiently target desired

viewers of particular advertisements (col. 11, l. 43-49). It would have been obvious to one of

ordinary skill in the art at the time that the invention was made to modify Arsenault et al. to

include receiving ad selection rules over telephone or from the World Wide Web, such as that

taught by Zigmond et al. in order to provide an improved system for directing television

advertisements to interested viewers (Zigmond et al. col. 3, l. 62-64).

Referring to claim **35**, the combination of Arsenault et al. and Zigmond et al. teaches the

system of claim 34, wherein said device also parses instructions for how to store said content and

said advertisement (Arsenault et al. col. 15, l. 1-11 & col. 18, l. 1-19).

Referring to claim **41**, the combination of Arsenault et al. and Zigmond et al. teaches the

system of claim 35, including content guide software to receive interruption instructions for

interrupting said content and replacing it with said advertisement (see claim 8 above)(Zigmond

et al. col. 17, l. 21-31).

3.   Claims **44, 45, 47** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Arsenault et al. in view of Armstrong et al.

Referring to claims **44, 45,** and **47**, Arsenault et al. discloses the method of claim 1.

Arsenault et al. does not disclose that the finding includes detecting that a user paused using said

content, and retrieving said advertisement from said cache when it is detected that said user

paused using said content. Arsenault et al. further does not disclose that the detecting includes

detecting that the user temporarily stopped using the content. Arsenault et al. still further does

not disclose inserting said advertisement in response to a pause in the display of said content.

Armstrong et al. discloses presenting advertisements to a user in response to the user pausing

video-on-demand content (col. 2, l. 14-22, 63-67; col. 3, l. 1-3; & Fig. 4). It would have been

obvious to one of ordinary skill in the art at the time that the invention was made to modify the

ad insertion of Arsenault et al. to include inserting advertisements in response to a user pausing

content, such as that taught by Armstrong et al. in order to put "freeze frame" or other similar

display imagery to greater uses (Armstrong et al. col. 1, l. 63-67).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to MICHAEL VAN HANDEL whose telephone number is

(571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art Unit 2424

MVH